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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/393,718	09/10/1999	FARZAD NAZEM	17887-3-1US	3195

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PHILIP H ALBERT
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO, CA 941113834

EXAMINER

NGUYEN, CINDY

ART UNIT

PAPER NUMBER

2171

24

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PRE

Office Action Summary

Application No.

09/393,718

Applicant(s)

NAZEM ET AL.

Examiner

Cindy Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10--28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z. 6) ☐ Other: _____

DETAILED ACTION

This is in response to amendment filed 06/02/03.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 06/02/03 has been entered.

1. Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10, 15-18, 25-28 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over U. S. Patent No. 5983227 of using different wording sequencing does not served as a basis for patentability.

Claims comparison table

09/393718	5983227
10	2
15, 25	3
16, 26	7
17, 27	8
18, 28	9

Regarding claims 10, 15-18, 25-28 of the '718 application, the claimed invention is drawn to the same subject matter as that claimed in claims 2, 3, 7-9, respectively of the '227 patent, except for (1) "using a page server" (col. 20, line 1, '227 patent), (2) "providing real time responses " (col. 20, lines 1, 2, 227, patent) (3) the step of "obtaining user preferences ..." and (4) the step of performed in real time response to receipt of the user request ...". Instead, the '718 application claims (1) in a page server, (2) providing a customized page to a user, (3) wherein the customized page is customized according to the user's preferences, (4) wherein the customized page includes at least one item of real-time information selected from the storage device. Nonetheless, the Blinn '622 teaches (1), (2, (3) and (4). It would have been obvious to one with ordinary skill in the art at the time the invention was made to broaden the invention because this provides a wider application of the invention with no additional cost in development.

2. Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Blinn et al. (U.S. 5897622).

In consideration of claim 10, Blinn et al. discloses: “In the page server coupled to a network, a method of providing a customized page to a user, wherein the customized page is customized according to the user’s preferences,”(see Fig. 3A, Blinn et al.), “ the method comprising the steps of:

obtaining real-time information from information sources (see col. 8, lines 53-57, Blinn et al.),

storing the real-time information in a storage device (see col. 9, lines 4-10, Blinn et al.),

receiving, from a user and at the page server (see col. 9, lines 14-23, Blinn et al.) a user request for a customized page (see col. 10, lines 6-8, Blinn et al.), and

executing a template program specific to the user using the real-time information stored in the storage device as input to the template program to generate the customized page, wherein the template program indicates items of interest to the user (see also col. 3, lines 45-55 and fig. 13A, Blinn).

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“and providing the user with the customized page (see col. 11, lines 4-7, Blinn et al.), wherein the customized page includes at least one item of real-time information selected from the storage device (see col. 11, lines 16-22, Blinn et al.).

As per claim 11, the limitations of this claim have been noted in the rejection of claim 10. Applicant's attention is directed to the rejection of claim 10 above. In addition, Blinn et al. discloses further including prior to the step of receiving the user request the steps of caching the template program in a storage location local to the page server” (see col. 11, lines 50-56, Blinn et al.).

Regarding claim 12, the limitations of this claim have been noted in the rejection of claim 10. Applicant's attention is directed to the rejection of claim 10 above. In addition, Blinn et al. discloses “further comprising the step of receiving user preferences for the user” (see col. 11, lines 60-62, Blinn et al.), “wherein the user preferences indicate the items of interest to the user” (see col. 12, lines 63-66, Blinn et al.), “and combining the user preferences with a generic template to form the template program specific to the user” (see col. 11, lines 67 to col. 12, lines 6, Blinn et al.).

Regarding claim 13, the limitations of this claim have been noted in the rejection of claim 12. Applicant's attention is directed to the rejection of claim 12 above. In addition, Blinn et al. discloses “further including the step of providing the template program specific to the user to the page server” (see col. 14, lines 39-44, Blinn et al.).

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Regarding claim 14, the limitations of this claim have been noted in the rejection of claim 12. Applicant's attention is directed to the rejection of claim 12 above. In addition, Blinn et al. discloses: "wherein the page server performs the step of combining the user preferences with the generic template" (see col. 7, lines 29-38, Blinn et al.).

4. *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blinn et al. (U.S 5897622) in view of DuFresne (U.S 5835712).

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Regarding claim 19, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Blinn disclose: obtaining user preferences for the plurality of users, wherein a user's user preferences indicate items of interest to that user (see col. 8, lines 1-16, Blinn).

However, Blinn didn't disclose: each of the plurality of users, combining the user preferences for a specific user and a template to form a template program specific to the user at the page server. On the other hand, Dufresne disclose: each of the plurality of users, combining the user preferences for a specific user and a template to form a template program specific to the user at the page server (col. 10, lines 18-32, DuFresne). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include more than one templates program specific to the user in the system of Blinn as taught by Dufresne. The motivation being to enable the user to create a specific template for the user and protects a access control lists so only authorized user can access to the specific template.

Regarding claim 20, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Blinn/Dufresne discloses: a second template program specific to the second user (col. 9, lines 50-59, Dufresne) using the real time information stored in the storage device as input to the second template program to generate a second customized page for a second user (col. 10, lines 7-32, Dufresne). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include more than one templates program specific to the user in the system of Blinn as taught by Dufresne. The motivation being to enable the user protects a access control lists so only authorized user can access to the specific templates.

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6. Claims 15-18 and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blinn et al. (U.S 5897622) in view of DuFresne (U.S 5835712) and further in view of Gerace (U.S. 5848396).

Regarding claims 15 and 25, Blinn/DuFresne disclose all the limitations of these claims have been noted in the rejection of claims 10 and 20 above, respectively. However, Blinn/DuFresne did not specifically disclose the limitations of claims 15 and 25. On the other hand, Gerace discloses: "wherein the real-time information comprises stock quotes, sports scores and news headlines" (see col. 6, lines 22-40, Gerace). Thus, it would have been prima facie obvious to a person of ordinary skill in the art to include the information includes stock information, advertisements, sports statistics, weather reports and the like in combination system of Blinn/DuFresne as taught by Gerace. The motivation being to have a dynamic page generator, in communication with the order processing module, to compose a page for display by processing a template having all difference kinds of information as stock information, advertisements, sports statistics, weather reports in the system.

Regarding claims 16 and 26, all the limitations of these claims have been noted in the rejection of claims 10 and 20 above, respectively, In addition, Blinn/DuFresne/Gerace disclose further comprising a step of generating a default user configuration for the user based on demographic information of the user (see col. 6, lines 5-7, Gerace).

Regarding claims 17 and 27, all the limitations of these claims have been noted in the rejection of claims 16 and 26 above, respectively, In addition, Blinn/DuFresne/Gerace discloses:

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wherein the step of generating a default user configuration comprises the steps of: determining a default list of cities for a weather report based on user demographic information (see col. 8, lines 52-57, Gerace); and determining one or more sports teams for sports reporting based on user demographic information (see col. 8, lines 15-25, Gerace).

Regarding claims 18 and 28, all the limitations of these claims have been noted in the rejection of claims 16 and 26 above, respectively, In addition, Blinn/DuFresne/Gerace discloses: wherein the steps of determining comprise the steps of: obtaining user postal code information (see col. 21, lines 41-43, Gerace); translating the postal code information to user geographic position (see col. 21, lines 41-49, Gerace); comparing the user geographic position to geographic positions assigned to each city (see col. 22, lines 10-12, Gerace); and sports team (see col. 21, lines 65 to col. 22, lines 5, Gerace); and determining a threshold distance from the user geographic position which is greater than or equal to a distance to a predetermined nonzero number of cities and a predetermined nonzero number of sports team geographic positions "(see col. 31, lines 2-7, Gerace).

Regarding claims 21-24, most the limitations of these claims have been noted in the rejection of claims 2, 13-18, and 20 above respectively. It is therefore rejected as set forth above.

7. *Response to Arguments (filed 06/02/03)*

Applicant argues: nowhere in Blinn is disclosed or suggested that the template is specific to the user. In response, Blinn clear disclose the template is specific to the user as a template having a database request for page data and a database module, wherein the retrieved page data

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corresponds to the database request and wherein the database module retrieves the data in a manner that is independent of any database schema (see col. 3, lines 45-55 and fig. 13B).

Applicant argues Gerace does not disclose or suggest that a page display object is specific to a user. In response, Examiner agree, the examiner has reconsidered the patentability of claim 19 and new claims 20-27 and found them unpatentable under 35 U.S.C. 103, above.

8. Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 703-305-4698. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CN

Cindy Nguyen

June 20, 2003


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100